



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,619	12/10/2003	Ellen Lasch	37355-202	8507

7590 02/23/2006

Stephen T. Scherrer
McDermott, Will & Emery
227 West Monroe
Chicago, IL 60606-5096

EXAMINER

WALSH, DANIEL I

ART UNIT	PAPER NUMBER
----------	--------------

2876

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,619

Applicant(s)

LASCH ET AL.

Examiner

Daniel I. Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11-05 (IDS) and 01-06 (IDS).
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11-05, 01-06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the IDS received on 23 November 2005 and 20 January 2006. The indicated allowability of claims 1-19 is withdrawn in view of the rejection below. The Examiner has reconsidered the references applied in the previous Office Action, and believes they are appropriate to teach the claimed limitations. Any delay is regretted.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-9, and 13, 14, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda (US 5,004,899) in view of McLeroy (US 5,257,656).

Re claims 1-2, Ueda teaches a foldable transaction card with first and second sections hingably attached (FIG. 1a+). Ueda is silent to a housing surrounding the card with a hinge for

folding the housing. The Examiner notes that hinged boxes, wallets, purses, organizers, etc. for example, are well known and conventional for holding secure items, such as cards. Simply reciting a housing for a card it therefore obvious and conventional in the art, and as claimed, the housing is not integral to the card. Simply specifying a housing with a hinge that surrounds the card when folded, is obvious, as a means to removably hold the card. Re claim 18, a fold line is taught via FIG. 1a (a line of the card where a fold occurs). Re claim 19, Ueda teaches a strip 3 connected to first and second sections.

Ueda is silent to the housing having at least one dimension smaller than a standard transaction card when the housing is in the folded and closed state.

McLeroy teaches (FIG. 1) a wallet/card holder, with folded sides, than when closed, has a dimension smaller than a standard transaction card. The Examiner notes that when folded the width dimension of the housing is smaller than the length for example (a dimension) of a transaction card. The Examiner notes that it is well within the skill in the art to place a folded card in the card slot/hole, to transport the card. Though silent to actual hinges, the Examiner notes that the folds are interpreted as functional equivalent as hinging means to permit the different parts of the wallet to be opened/closed, and hence are interpreted as hinging means or hinges. The Examiner notes that as Ueda is drawn to an elastic/rubbery hinge, it is interpreted by the Examiner to be biased towards the flat position. Accordingly, the Examiner notes that placing the card of Ueda into the card slot of McLeroy up until the hinge part, and then closing the housing on the card (folding the card) would result in the second section of the card unfolding outside when the housing is open. One would have been motivated to do this for easy access to the card (opening the housing reveals the card easy to grasp). Re claim 2, it is clear

that the card is removable from the housing. Re claim 3, the Examiner interprets that by placing the card in the slot that it is attached to the housing (removably attached), in as much as the Applicants invention is attached via tracks. As the Applicants tracks merely hold the card, the slot is interpreted as attaching the card to the housing. Re claim 4, the Examiner notes that FIG. 2 teaches sections with hinging means disposed between. Re claims 5-8, the Examiner notes that the slot/pocket of the wallet is broadly interpreted as a track means to accept the card disposed therein, to attach the card to the housing (removably). Re claim 9, FIG. 2 shows the housing has an opening to access a card. Re claim 13, as the card is disposed in the cardholder it is interpreted as attached/removably attached. Re claim 14, Ueda teaches an IC card. The chip is interpreted as a storing means for storing information on the card, readable by a reader.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Ueda with those of McLeroy.

One would have been motivated to do this in order to have a means to transport the card in a folded position to protect the card and keep it out of sight.

The Examiner notes that it is well known that a folded card can be put in the pocket/sleeve of a wallet, for example, in a folded position, whereby when the wallet/housing is opened, the card is able to be unfolded. Further, the Examiner notes its well-known and conventional for magnetic stripes to be disposed on a card, in addition to or in place of IC chips, depending on the desired application/functionality/storage, and that such modification is obvious in the art for those reasons. Further, depending on how the card and wallet/housing are manipulated, it is obvious that the card can be read both while it still remains in the

wallet/housing (by folding parts of the wallet while still keeping the card disposed therein, and also by simply removing the card).

3. Claims 1, 2, 3, 4, 5, 6, 9-14, 18, and 19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda in view of Elnekaveh (US 6,823,910).

Re claims 1-2, Ueda teaches a foldable transaction card with first and second sections hingably attached (FIG. 1a+). Ueda is silent to a housing surrounding the card with a hinge for folding the housing. The Examiner notes that hinged boxes, wallets, purses, organizers, etc. for example, are well known and conventional for holding secure items, such as cards. Simply reciting a housing for a card it therefore obvious and conventional in the art, and as claimed, the housing is not integral to the card. Simply specifying a housing with a hinge that surrounds the card when folded, is obvious, as a means to removably hold the card (see US 4,884,507). Re claim 18, a fold line is taught via FIG. 1a. Re claim 19, Ueda teaches a strip 3 connected to first and second sections.

Ueda is silent to the housing having at least one dimension smaller than a standard transaction card when the housing is in the folded and closed state.

Elnekaveh teaches a money clip and cardholder (FIG. 1). Though Elnekaveh teaches a card holding receptacle on one side, the Examiner notes that the money clip itself is interpreted as a housing that surrounds a card in a folded state. The housing has a dimension smaller than a transaction card (its narrower than a standard transaction card length). The Examiner notes that if a folded card is placed under the clip, it is interpreted by the Examiner that the folded card would unfold outside the housing. One would have been motivated to do this in order to protect the security of the cards while in the clip (not allowing all card information to be viewed when

the card is folded, for example). Re claim 2-6, 9, 10, and 11, the limitations are taught via FIG.

1. The Examiner interprets the money clip as a housing that surrounds the card, that the card is removably attached by being clipped to the housing, that the spring-loaded hinge is an actuator with opening means to open the housing/clip to access the foldable cards. Re claim 12, the Examiner notes that the spring-loaded hinge allows the housing to spring open when open (springs are known to be biased to close/open). Therefore the Examiner notes it is obvious that when opened, the spring is interpreted to “spring” open. Re claim 13, the card in the clip is interpreted as attached to the housing. Re claim 14, the card has a chip, as discussed above, readable by a reader.

4. Claims 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda/McLeroy, as discussed above, further in view of Keller (US 5,700,037).

The teachings of Ueda/McLeroy have been discussed above.

Ueda/McLeroy are silent to magnetic stripe.

The Examiner notes that magnetic stripes are a well known and conventional means of storing data on a card, as are IC/chips.

Specifically, Keller teaches a foldable card with a magnetic strip (FIG. 1).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Ueda/McLeroy with those of Keller.

One would have been motivated to do this as a matter of design variation, as an alternative storage means for a card, which can be cheaper to produce and more readably read by older card readers (magnetic stripe card readers).

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda/McLeroy/Keller, as discussed above, in view of Pentz et al. (WO 02/067190), as cited by the Applicant.

The teachings of Ueda/McLeroy/Keller have been discussed above.

Ueda/McLeroy/Keller are silent to the magnetic stripe being readable without removing the card from the housing.

Pentz et al. teaches that the magnetic stripe can be disposed in different sides (FIG. 4D), which is a side that can be read when the card is in the holder and only that side is unfolded, as discussed re claim1.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Ueda/McLeroy/Keller with those of Pentz et al.

One would have been motivated to do this in order to reduce the amount of wear from removing the card from a pocket, or to add to user convenience or security by not having to remove the card.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

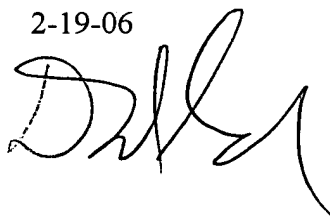
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh

Examiner

Art Unit 2876

2-19-06

A handwritten signature in black ink, appearing to read 'D. Walsh', with a long, sweeping horizontal stroke extending to the right.